

REMARKS/ARGUMENTS

The Final Office Action

In the above-mentioned Final Office Action claims 181-186, 188-194, 197-212, 214-234, 236-264 and 269-271 were rejected under 35 USC 102(e) as being anticipated by U.S. Patent 6,380,132 (*Mihara*). In response thereto, no claims have been amended or cancelled and no new claims have been added.

The Final Office Action is unclear as described in detail later in this paper. Briefly, the examiner says in paragraph 3 that the grounds of rejection have been “updated,” in paragraph 4 he says that the grounds of rejection are “maintained” and in paragraph 5 he says that due to a new interpretation of the claims, Applicant’s prior arguments also over *Mihara* are moot. Further, the action was made a Final Office Action implying that the grounds of rejection have not been changed.

In any event, Applicant provides two main sections in the subject Response paper. The first main section (Section I) discusses how the claims are patentable over *Mihara* based on the rejections as best understood by Applicant. This first section requests that a Notice of Allowance issue. The second main section (Section II) discusses the problems and confusions of the subject Final Office Action and requests that a new Office Action, which is a non-final Office and which also fully explains the rejections, be issued in the event that the Notice of Allowance is not issued.

I. ISSUANCE OF A NOTICE OF ALLOWANCE IS IN ORDER

The law is clear that anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference, arranged or combined in the same way as recited in the claim, either expressly or inherently. *New MoneyIN, Inc. v. Verisign, Inc.* ---F.3d. ---,

2008 WL 4614511, at 8 (Fed. Cir. Oct. 20, 2008). The claims are not anticipated by *Mihara* for the following reasons.

A. Mihara Does Not Disclose “Separate Sheet Portions”

Claim 181 – Referring to the last three paragraphs, separate sheet portions are claimed and the lower bottom-most surfaces of both of the separate sheet portions are formed by the lower bottom-most surface of the sheet structure. This is not taught by *Mihara* nor has the examiner pointed out how it is taught.

Claim 200 – Referring to the last three paragraphs thereof, separated individual sheet portions are claimed, each of which includes a portion of the first layer and a portion of the second layer secured to the portion of the first layer. This is not taught by *Mihara* nor has the examiner pointed out how it is taught.

Claim 223 – Referring to the last two paragraphs thereof, separate sheet portions are claimed each of which includes a portion of the first layer and a portion of the second layer secured to the portion of the first layer. This is not taught by *Mihara* nor has the examiner pointed out how it is taught.

Claim 242 – Referring to the last three paragraphs thereof, separated individual sheet portions are claimed each of which includes a portion of the first layer and a portion of the second layer secured to the portion of the first layer. This is not taught by *Mihara* nor has the examiner pointed out how it is taught.

Where are these separate sheet portions disclosed in *Mihara*? *Mihara* does not disclose sheet portions and certainly does not disclose separate sheet portions as all of the layers are connected to layer 5 as depicted in FIG. 5, for example.

B. Mihara Sheet Is Not Constructed so as to Split When Bent As is Claimed

As explained in paragraph 11 of Dr. Ugolick's Declaration dated February 15, 2007 and filed on February 21, 2007, the *Mihara* sheet does not split when bent. That paragraph is copied below and is hereby incorporated by reference.

11. *Mihara et al.* does not describe a construction which splits, divides or separates into attached first and second layer portions when folded, and specifically when folded or bent upwardly only once or downwardly only once. Cut 2 of *Mihara* is provided to separate the adhesive label 9 from the release sheet 5. (See Abstract; col. 3, lines 18-21; col. 3, lines 49-54; and col. 5, lines 50-55.) In fact, *Mihara et al.* does not want the release sheet 5 to break or split at the cuts 2 as this would make it more difficult to initiate removal of the labels from the release sheet by separating an easily graspable portion of the label from the release sheet. That is, users want to be able to easily grasp and peel off a unitary predefined sheet adhesive sheet portion or label without fracturing the release sheet in a *Mihara et al.* type of construction. If a portion of the release sheet were to crack and break off and remain adhered to the label, it would defeat the purpose of the *Mihara* cuts 2, which is to facilitate removal of the labels from the release sheet.

The examiner did not respond to the arguments and logic of Dr. Ugolick's Declaration in the subject Final Office Action. This is a clear error, Applicant respectfully contends.

The examiner's statement in paragraph 4 of the Final Office Action that the half cut line 2 splits layers 6-8 of *Mihara* is not relevant to the present claims which describe the structural properties of Applicant's sheet which splits when bent. The claims do not mention that the sheet splits when cut. Referring to Dr. Ugolick's Declaration quoted above, *Mihara* does not split when bent. Whether or not it splits when cut is not relevant.

C. The Intended Scope of the Term “Split” is Clear

The term “split” was included in claims in Applicant’s Amendment filed November 25, 2002, over six years ago, and has been the subject of eight or so Office Actions. This is the first time that the examiner has questioned what the “intended scope” of “split” was. Accordingly, if the present examiner and the prior examiner had no issues with the scope of “split” through numerous Office Actions, its scope must be clear.

The scope of the term “split” is also clear from paragraph 11 of Dr. Ugolick’s Declaration discussed and copied later in this paper.

Further the scope of the term “split” is clear from the description of the “sheet portions” in the last two paragraphs of claim 181, from the last two paragraphs of claim 200, the last paragraph of claim 223, and the last two paragraphs of claim 242. Applicant’s sheet has structural properties to split from the bottom end of the cut to the bottom surface of the sheet when bent on the cut line to separate the sheet into two separate portions.

**II. THE FINAL OFFICE ACTION IS DEFECTIVE AND INTRODUCES NEW ISSUES AND
THUS THE ISSUANCE OF A NEW NON-FINAL OFFICE ACTION IS IN ORDER.**

A. The Anticipation Rejections are Unclear and Confusing

The examiner’s anticipation rejections over *Mihara* are unclear and confusing and thus the Final Office Action is defective. Accordingly, the issuance of a new Office Action explaining, restating and clarifying the rejections is in order, preferably without reference to the rejections in the examiner’s prior Office Actions.

On the one hand, the examiner contends in paragraph 4 that the grounds of rejection as set forth in the prior Office Actions mailed 6/3/2008 and 5/3/2007 are maintained. But on the other

hand, the examiner says in paragraph 5 that applicant's arguments to the prior rejections (Remarks pages 17-34) "are moot." They are moot because "the structural feature of the claimed invention has been considered as set forth above [in paragraph 4]." Consequently, it is not clear whether the rejections in the prior Office Actions are being repeated or not. If they are being repeated, then the examiner must respond to Applicant's arguments in his last Amendment (pages 17-34). *See* MPEP 707.07(f) which says that "[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." (Emphasis added.) If the rejections in the prior Office Actions have been withdrawn then the rejections in this Final Office Action must be fully set forth, and where and how each of the claim elements in each of the independent (and dependent) claims are suggested by *Mihara* must be fully explained. Applicant should not be forced to pick and choose which aspects of the rejections in the prior Office Actions are being maintained and which are not being maintained to create the examiner's new rejections.

B. "Use Step" in Office Action is Not Understood

In paragraph 4 of the Final Office Action the examiner refers to a "use step." This term is not understood. Counsel could not find that term used in the MPEP. If it means "intended use" then that interpretation has been fully addressed and responded to in pages 17-35 in Applicant's last Amendment. The examiner, however, said in paragraph 5 that those arguments were no longer applicable and that he would not respond to them. The meaning of "use step" is thus not clear.

Further, the examiner did not respond to Applicant's request in the paragraph bridging pages 17 and 18 of the last Amendment that the examiner include specific MPEP citations and other explanations for any further rejections which use the term "use step" (and other terms). Those requested citations and explanations were not provided in the subject Final Office Action.

C. The Subject Office Action was Improperly Made a Final Office Action

Referring to section IIA above and as can be best understood, the examiner appears to be picking and choosing some portions of the rejections in the prior Office Actions and adding new aspects to them. If this is true, these rejections constitute new rejections, and thus the subject final Office Action should have been a non-final Office Action.

Referring to section IC above, the examiner raised a new issue that the intended scope of “split” is unknown. Accordingly, the subject Office Action should have been a non-final Office Action.

Referring to section IIB above, the examiner is now using a “use step” argument to reject all of the claims, which was not previously done. Accordingly, the subject Office Action should have been a non-final Office Action.

III. REQUEST THAT THE SPE CO-SIGN ALL FUTURE OFFICE ACTIONS

Applicant’s last Amendment included on page 34 a request that the SPE co-sign all future Office Actions. That request is hereby made again for the reasons set forth in that Amendment, reasons discussed below and in keeping with the Patent Office’s Policy of Compact Prosecution.

The present Office Action is the eleventh Office Action in the present application. Referring to MPEP § 707.02, “... The supervisory patent examiners are expected to personally check on the pendency of each application which is up for the third or subsequent Office action with a view to finally concluding its prosecution.”

Accordingly, Applicant hereby requests that the examiner obtain the Supervisory Primary Examiner’s signature on all subsequent Office Action in this application.

Conclusions


For reasons explained in detail above, it is requested that the examiner's next communication either be a Notice of Allowance or a new Office Action that is a non-final Office Action and that also fully explains the rejections.

The examiner is invited to call the undersigned patent counsel for Applicant to answer any questions or to discuss steps necessary for placing this application in condition for allowance.

With respect to this filing, the Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 503456. Should such additional fees be associated with an extension of time, Applicant respectfully requests that this paper be considered a petition therefor.

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Respectfully submitted,



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